

**REMARKS**

Claims 1-10, 21, 22 and 25-29 are pending in the present application. Claims 1-10, 28 and 29 are withdrawn subject to a restriction requirement. Reconsideration of the application is respectfully requested in view of the following responsive remarks.

In the Final Office Action of June 16, 2004, claim 27 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. 5,997,622 (hereinafter “Weber”) as evidenced by U.S. 5,605,750 (hereinafter “Romano”).

It is respectfully submitted that the presently pending claims be examined and allowed. Applicants submit that each and every claim herein, and throughout the prosecution of the present application is fully supported by the specification as originally filed, and that no new matter has been added. The remaining specific species are believed to be novel and nonobvious over the prior art of record, as will be described in more detail below.

**Rejections under 35 U.S.C. § 102(b)**

The Examiner has rejected claim 27 under 35 U.S.C. §102(b) over Weber as evidenced by Romano. (NOTE: There is an inconsistency regarding claims 21, 22, 25, and 26, as these claims are listed on page 2 of the Final Office Action as rejected, but are listed on the Office Action Summary sheet and on page 4 as allowed. The Applicants' response is based on the weight of the Final Office Action where it appears that only claim 27 was rejected).

As in the prior response, the Applicants respectfully request that the Examiner review the relevant case law showing that a rejection based on a disclosure such as Weber is improper in that it fails to recite or suggest the specific chemical combination of the claimed invention. It is thought proper to briefly state what is required to sustain such a rejection. It is well settled that "[a] claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). Importantly, it is well established that a mere recitation of a long list of chemical moieties for use in a general genus, does not constitute an enablement of each of the possible chemical structures. Specifically, the Federal Circuit has stated:

Clearly, however, just because a moiety is listed as one possible choice for one position does not mean there is *ipsis verbis* support for every species or sub-genus that chooses that moiety. Were this the case, a "laundry list" disclosure of every possible moiety for every possible position would constitute a written description of every species in the genus. ***This cannot be*** because such a disclosure would not "reasonably lead" those skilled in the art to any particular species. *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 U.S.P.Q.2d 1895 (Fed. Cir. 1996) (emphasis added).

Also specific to chemical claims, the Court has held that a claim including a genus will not anticipate a claim to a species unless the specific compound is clearly named or can be "clearly envisaged" from the generic formula. *Ex Parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). In order to be "clearly envisaged" from the formula, the reference must disclose "sufficiently limited or well delineated classes of substituents." *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962). This can be accomplished by teaching a preferred substituent *Id.* or a limited number of related species. *In re Schauman*, 572 F.2d 312, 197 USPQ 5 (CCPA 1978).

In the previous response, the Applicants pointed out that that Weber gives only laundry lists of possible groups for Z, X1 and X2 that could be attached to the polyvalent transition metal complex of 8-heterocyclazo-5-hydroxyquinoline. The Examiner has cited groups selected from these laundry lists as the basis for the rejection of claim 27. As stated in the prior response, combinations of moieties suggested by these lists would result in over 23,000 differing complexes. It is the position of the Applicants that this number of combinations could not possibly qualify as a limited number of related species. Moreover, Weber fails to provide direction and/or suggestion as to what moieties to pick to arrive at the chemical structure of claim 27. Further, Weber does not disclose a preferred embodiment that would include the compound of the present invention. Hence, it is evident that the specific compound of claim 27 is not “clearly envisaged” by the broad genus of Weber.

The court has clearly held that merely picking and choosing from laundry lists will not anticipate a claim to a specific species. As before, Applicants respectfully contend that the list relied on by the Examiner is merely a laundry list of the type rejected by the Court as enabling prior art for claims of specific compounds. In the final Office Action, the Examiner has merely cited these same lists as providing the suggestion for the specific chemical structure of the claimed invention. The Examiner has neglected to provide reasoning as to how the multitude of possible compounds disclosed in Weber could reasonably lead one skilled in the art to arrive at the particular species of the claimed invention. As such, the Examiner *cannot* merely point to the laundry list at issue to support the presence of a suggestion. To do so would turn the case law on its head. The Examiner’s reasoning is tantamount to pointing to the dictionary as anticipatory of any phrase contained in the works of Shakespeare or pointing to a range of musical scales as anticipatory of any movement to be found in the compositions of Mozart. In other words, the issue at hand is that a laundry list of possible chemical constituents cannot create anticipation of one specific species. Pointing to that very laundry list to support that a suggestion for picking and choosing certain specific constituents is present amounts to bootstrapping. Thus, the Applicants respectfully request that claim 27 be allowed.


In view of the foregoing, Applicants believe that claims 21-22 and 25-27 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above

remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone W. Bradley Haymond (Registration No. 35,186) at (541) 715-0159 so that such issues may be resolved as expeditiously as possible.


Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025.

Dated this 16<sup>th</sup> day of Aug., 2004.

Respectfully submitted,



M. Wayne Western  
Attorney for Applicants  
Registration No. 22,788



Gary P. Oakeson  
Attorney for Applicants  
Registration No. 44,266

Of:

THORPE NORTH & WESTERN, LLP  
8180 South 700 East, Suite 200  
Sandy, Utah 84070  
(801) 566-6633

On Behalf Of:

HEWLETT-PACKARD COMPANY  
1000 NE Circle Blvd., m/s 422B  
Corvallis, OR 97330-4239  
(541) 715-0159